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13 JAN 2006

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In re Application of DEL SOLDATO et al
U.S. Application No.: 10/516,938
PCT Application No.: PCT/EP03/06502
Int. Filing Date: 20 June 2003
Priority Date Claimed: 25 June 2002
Attorney Docket No.: 026220-00058
For: NITROOXYDERIVATIVES OF
CYCLOOXYGENASE-2 INHIBITORS

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. §1.47(a)" filed 13 September 2005.

BACKGROUND

On 20 June 2003, applicant filed international application PCT/EP03/06502, which claimed priority of an earlier Italy application filed 25 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 31 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 25 December 2004.

On 14 December 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 23 May 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 13 September 2005, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Piero Del Soldato refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application to Del Soldato for signature. Specifically, letters were sent to Del Soldato via registered mail on two separate occasions (see affidavit of Marie Teresa Noro). Furthermore, the petition sufficiently establishes that Del Soldato refuses to sign. In particular, the petition specifically states that Del Soldato's attorney, Fabrizio Conte, signed a copy of each letter that was sent to both Del Soldato and Conte. Given that Del Soldato's attorney received both letters and Del Soldato's continued failure to respond, it is reasonable to conclude that Del Soldato refuses to join in the application.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to \$200.00. Any fee deficiency will be charged to Deposit Account No. 01-2300 as authorized by applicant.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 20 June 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 13 September 2005.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



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13 JAN 2006

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For: NITROOXYDERIVATIVES OF
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Dear Piero Del Soldato:

You are named as a joint inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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